IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/652,261	Examiner: Salce, Jason P.
	Group/Art Unit: 2623
Filed: August 29, 2003	Atty. Dkt. No: 5266-08801
Inventor(s):	
Frederick B. Harris	
Title: VIDEO-ON-DEMAND AND TARGETED ADVERTISING	

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Rory D. Rankin
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/Rory D. Rankin/   April 21, 2008
Signature   Date

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated below.

Applicant is in receipt of the Advisory Action mailed April 8, 2008. Claims 1-23 remain pending in the application. Reconsideration of the present case is earnestly requested in light of the following remarks.

Claims 1-3, 8, 10-11, 15-18 and 20-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,945,987 (hereinafter "Dunn"), in view of U.S. Patent No. 6,453,471 (hereinafter "Klosterman"). In addition, claim 9 stands rejected under 35 U.S.C. § 103(a) over Dunn in view of Klosterman. Claims 4 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn in view of Klosterman in further view of U.S. Patent No. 6,378,130 (hereinafter "Adams"). Claims 5 and 13 stand rejected under 35 U.S.C. § 103(a) over Dunn in view of Klosterman, in further view of U.S. Patent No. 6,144,402 (hereinafter "Norsworthy"). Claim 6 stands rejected under 35 U.S.C. § 103(a) over Dunn in view of Klosterman, in further view of U.S. Patent No. 7,032,028 (hereinafter "Clay"). Claims 7 and 14 stand rejected under 35 U.S.C. § 103(a) over Dunn in view of Klosterman, in further view of U.S. Patent No. 5,861,906 (hereinafter "Dunn2"). The following clear errors in the Examiner's rejection are noted.

In the Office Actions dated May 11, 2007 and November 1, 2007, the Examiner suggested that claims 1, 10, 16, 18 and 20 are unpatentable over Dunn in view of Klosterman. Applicant disagreed and in response to Applicants arguments, the Examiner suggested

"although Applicant has suggested what the combination of Dunn and Klosterman may teach, the Applicant has not argued how these proposed teachings fail to teach the claims limitations. As stated in the previous Office Action, Dunn teaches all of the claim limitations, but is silent as to the use of a broadcast carousel."

Applicant first noted that Dunn merely discloses a video-on-demand system in which previews of available videos are displayed from which a viewer may select an associated program to be ordered. More specifically, Dunn discloses an STB receives initial data from the headend and default previews are displayed. A viewer may then specify criteria (e.g., a star name) and transmit a corresponding request to the headend. The headend uses the request to locate records matching the criteria and returns data in response (i.e., the list of matches). The viewer may then request play of a trailer from the list of matches by sending a request to the headend. In response to the viewer request, the headend transmits the trailer.

What should be appreciated from the above is that Dunn fails to teach "retrieving a first module of said modules at the client device from the single channel, in response to matching the received qualifying module number to said first module," as recited. The recited "said modules" are "not broadcast responsive to a client request," whereas Dunn discloses retrieving programs that match a search request that are transmitted in response to the search request.

On page 3 of the Advisory Action dated April 8, 2008, the Examiner disagreed with Applicant's arguments and stated:

"[W]hile Dunn teaches broadcasting a plurality of modules in a continuous loop, wherein said plurality of modules are not broadcast responsive to a client request (see Column 12, lines 17-19), Dunn only teaches doing so for "new releases" of trailers (see again column 12, lines 17-19) and not when a new group is selected. Dunn can access the new group of trailers in a next/previous fashion (See column 12, lines 48-56), however in regards to the new group of trailers, Dunn is silent about the use of a broadcast carousel because the viewer must send a request to the server each time a next or previous trailer is to be retrieved from the server. Therefore, while Dunn provides technology similar to a broadcast carousel, by transmitting new release trailers in a continuous loop, Dunn fails to teach that a carousel is used for the group of trailers selected using the viewer's search criteria, hence the application of the trailer carousel of Klosterman in the 103(a) rejection."

However, the Examiner would appear to be agreeing that Dunn's trailers, one or more of which may be retrieved by the client, are broadcast responsive to a client request and therefore are not equivalent to the claimed "first module of said modules." For at least this reason, Applicant submits claim 1 is patentably distinguished from Dunn.

As to the combination of Dunn and Klosterman, in the Office Action dated November 1, 2007, the examiner admits that Dunn does not disclose the recited broadcast carousel and the recited modules not being broadcast responsive to a client request. The examiner then cites Klosterman as disclosing these features and suggests the combination of Dunn and Klosterman

meets the presently claimed invention. However, Klosterman merely discloses a preview channel in which trailers are repeatedly transmitted in a carousel or a loop. More specifically, Klosterman discloses a list of available previews is provided to a viewer. The viewer may select a trailer/preview video from the provided list. The selected trailer is then displayed. In one embodiment, the trailers are transmitted on a carousel. However, Klosterman's user merely selects a trailer/preview without matching a received qualifying module number. Applicant finds no teaching or suggestion in Klosterman of "retrieving a first module of said modules at the client device from the single channel, <u>in response to matching the received qualifying module number to said first module</u>," as is recited in claim 1.

Furthermore, the combination of Dunn and Klosterman merely provides a system in which programs may be selected in two different ways. First, as taught by Dunn, a user may retrieve programs that match a search request that are also transmitted in response to the search request. Second, as taught by Klosterman, a user may select a trailer/preview from whatever is presented, but without matching any search criteria. However, combining Dunn with a list of available trailers and transmitting trailers on a preview channel in a carousel does not result in the claimed invention. In such a combination, there is no connection between the request sent by the viewer to the headend (i.e., the request for a new group of trailers in Dunn) and the retrieval of pushed modules (i.e., selecting a trailer for preview from a list in Klosterman). Rather, the combination merely results in the VOD system of Dunn with a list of available trailers for preview from a preview channel (the trailers being transmitted on the preview channel in a carousel). Therefore, a viewer may simply select for display a non-requested trailer from a predetermined list – or, a viewer may request conveyance of further trailers and select from the requested and returned trailers.

Applicant finds no teaching or suggestion that the request sent by the viewer to the headend (i.e., Dunn's request for a new group of trailers that match a set of search criteria) would result in receiving a qualifying module number that would match a trailer as taught by Klosterman (i.e., a pushed trailer). Nor would there be any motivation to attempt to match a qualifying module number to Klosterman's pushed trailers, since Dunn does not teach matching search criteria to the new releases previews. Alternatively, in the proposed combination, a viewer may select a preview from an EPG such as is provided in Klosterman's system. However, Applicant finds no suggestion to modify this method of viewing a preview by sending search criteria to the headend to determine which preview matches the criteria.

Also, on page 4-5 of the Advisory Action dated April 8, 2008, the Examiner suggests

"Dunn's trailers that have been retrieved based on search criteria specified by the viewer, are only retrieved from the CMS database, each time the user requests to view the previous or next trailer. This process requires a video to be retrieved from the database, each time the user request the video. Alternatively, Klosterman teaches placing trailers on a single channel and cyclically transmitting the trailers in a broadcast carousel (see Figure 10). The addition of such a transmission scheme to the system of Dunn would result in not only requiring less bandwidth to transmit multiple trailers in a single broadcast stream/channel (see Column 10, lines 45-46 of Klosterman), but even further eliminate any additional processing steps requires by the server of Dunn by having the database queried and a preview/trailer retrieved every time a request from the viewer has been issued. Therefore, Dunn would benefit from the transmission scheme of Klosterman and one of ordinary skill in the art would be motivated to make such a modification to the system of Dunn."

However, Applicant again submits the proposed combination fails to produce the presently claimed invention. In the proposed combination, Klosterman's carousel would be loaded with the trailers that were determined to have matched the search criteria and that also would therefore be broadcast in response to a request, unlike the recited first module that is <u>not broadcast responsive to a client request</u>. Accordingly, Applicant finds no teaching or suggestion in the cited art, taken either singly or in combination, of "retrieving a first module <u>of said modules</u> at the client device from the single channel, <u>in response to matching the received qualifying module number to said first module</u>," as is recited in claim 1.

It is also noted that Dunn discloses a system wherein a list is purposefully not utilized. For example, Dunn discloses:

> "This invention provides an interactive entertainment network system with a video-on-demand (VOD) application that is like having a video store in your own home. . . . preview video trailers for the set of programs are displayed. The VOD application permits the viewer to browse the trailers at their own rate, skipping forward to the next trailer or backward to the previous trailer. If the viewer settles on a particular program, <u>the VOD application allows the user to rent the program immediately from the trailer being displayed on their television set, without returning to a menu or other order screen</u>." (Dunn, col. 2, lines 23-36). (emphasis added).

Accordingly, Dunn may further be seen to teach away from the list type approach of Klosterman. For at least the above reasons, Applicant submits that claim 1 is patentably distinguished from the cited art, taken either singly or in combination. In addition, as each of independent claims 10, 16, 18 and 20 include similar features, each of these claims is believed patentably distinguished for similar reasons. As each of the dependent claims includes the features of the independent claims on which it depends, each of the dependent claims is patentably distinct for at least the above reasons.

Further, each of the dependent claims recite additional features not disclosed by the combination of cited art. For example, claim 3 recites the additional features:

> "a viewer generating a video request based upon said displayed information, said
> video being associated with said first module;
> sending said video request to said server; and
> sending a video corresponding to said video request from the server to the client
> device."

In the Office Action dated May 11, 2007, it is suggested 'said video being associated with said first module' is met by Dunn Fig. 13. Applicant respectfully submits that the combination of Dunn and Klosterman does not disclose all the features of claim 3. In contrast to the teachings of Dunn, the first module as recited in claim 1 is (1) not broadcast responsive to a client request and (2) matches a received qualifying module number, which corresponds to the search criteria. In order for Dunn's requested program being associated with the previews to be equivalent to the recited "video being associated with said first module," as suggested, one of Dunn's previews would have to be equivalent to the first module. However, Dunn's previews are either from a default set and hence not corresponding to the search criteria, or non-default and hence broadcast in response to a client request. Therefore, Dunn's previews are not equivalent to the claimed qualifying modules. Accordingly, Applicant submits claim 3 is patentably

distinguished from the cited art. In addition, as claims 11, 17, 18, and 22 include similar features, claims 11, 17, 18, and 22 are believed patentably distinguished for similar reasons.

Still further, Applicant does not find the features of claim 8, 15, 19, and 23 disclosed by Dunn. On page 5 of the Office Action dated May 11, 2007, the Examiner suggested Dunn discloses the features "sending a selected advertisement associated with the search request to the client device." On page 5 of the Office Action dated November 1, 2007, the Examiner responded to Applicant's argument that the next/previous trailer is not equivalent to "a selected advertisement associated with the search request" by stating that since Applicant has provided no reason as to why no such equivalent exists, the cited portion of Dunn stands. However, Applicant submits Dunn says nothing about including advertisements in the CMS database or associating advertisements with the search request. Furthermore, unlike the recited first module, the advertisements recited in claim 8 are sent in response to the search request. If, for the sake of argument, one assumes that one of Dunn's trailers is equivalent to the recited advertisement, then all of Dunn's trailers are equivalent to advertisements and are also sent in response to the search request. Therefore, Dunn's trailers are not equivalent to the recited first module of claim 1. Accordingly, claims 8, 15, 19, and 23 are patentably distinguishable from the combination of cited art.

In light of the foregoing remarks, Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested. If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 501505/5266-08801/RDR.

Respectfully submitted,

/ Rory D. Rankin /
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